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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/907,224	07/17/2001	Efraim Sagiv	102101-200	7334
7590 11/07/2003 Todd E. Garabedian, Ph.D. WIGGIN & DANA One Century Tower New Haven, CT 06508-1832			EXAMINER SZEKELY, PETER A	
			ART UNIT 1714	PAPER NUMBER

DATE MAILED: 11/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/907,224	SAGIV ET AL.	
	Examiner	Art Unit	
	Peter Szekely	1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/9/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Final Rejection imposed in Paper #8 is withdrawn by the examiner in order to make new rejections.

Specification

2. The disclosure is objected to because of the following: The paragraph added by amendment in the Preliminary Amendment is inconsistent with the preferred embodiment shown in the specification. Dispercoll U54 and Dispercoll U53 are both sulfonated polyester-urethanes according to U.S. Patent 6,180,244. See column 4, lines 30-36 of said U.S. Patent.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicants are claiming a non-sulfonated polyester-urethane as ingredient "A" in claims 1, 11 and 21. However, only the performance of Dispercoll U54 is demonstrated and the only alternative offered is Dispercoll U53. Both of these materials are sulfonated polyester-urethanes. It is not shown anyplace in the instant specification

that the claimed composition is capable of performing according to the requirements of said specification. The invention is not enabled.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. It is not clear from applicants' specification whether the claimed ingredient "A" is a sulfonated polyester urethane, a non-sulfonated polyester-urethane or are applicants claiming both embodiments. Although the MSDS by Bayer shows no sulfur content, it shows "other undetermined" ingredients and both Rayner et al. and Chemical Abstract refer to the Dispercoll series of polyester-urethanes as sulfonated polyester-urethanes. Clarification is required.

Claim Rejections - 35 USC § 102

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claims 1-6 and 9-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Rayner et al. 6,180,244.

10. Rayner et al disclose Dispercoll U54 (applicants' preferred embodiment as ingredient "A") and Neorez 9617 (an aqueous dispersion of aliphatic polyurethane) in Tables 2a, 2b, 3a and 3b. Solvents are listed in column 7, lines 17-34. Surfactants can be found in column 6, lines 29-38. Applicants' claims are not novel.

Claim Rejections - 35 USC § 103

11. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

12. Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rayner et al. 6,180,244, in view of Piret et al. 5,877,240.

13. Rayner et al, besides the disclosures of paragraph #10, also teach the use of silanes in column 6, lines 1-3. Although, gamma-glycidoxypyrroltrimethoxy silane is not mentioned, Piret et al. recite the use of said silane with polyester urethanes in claim 8. For concentrations see Example 1. For method of adhering see Rayner et al. column 9, lines 10-45. Although the temperature and pressure conditions are different from the limitations claimed by applicants, there is no importance attached to these conditions in the specification, since the invention lies in the composition, and one of ordinary skill in the art can optimize the processing conditions without undue experimentation. The substitution of the silane of Piret et al., into the composition of Rayner et al. is obvious too, since it is a preferred silane to use with polyester-urethanes according to the secondary reference.

14. Claims 1-25 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Rayner et al. 6,180,244, in view of Piret et al. 5,877,240.

15. Since component "B" can be a sulfonated polyester urethane it is assigned that role in this rejection, while component "A" is Neorez 9617 or its equivalents described in column 4, lines 37-43 of Rayner et al. Although the examiner does not know the exact

composition of these polyester-urethanes, a Chemical Abstract search performed by the Chemical Library of the Patent Office, (enclosed), shows that polyesters having the same tradenames have similar building blocks and that there is nothing extraordinary or novel about these ingredients. The burden is shifted to applicants to show that none of the cited non-sulfonated polyester urethanes have the same chemical composition as component "A" cited by applicants and that accordingly applicants' composition is novel and non-obvious.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Szekely whose telephone number is (703) 308-2460. The examiner can normally be reached on 7:00 a.m.-5:30 p.m. Tuesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Peter Szekely
Primary Examiner
Art Unit 1714

P.S.
11/04/03

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